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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,166	11/14/2003	Matthias Von Samson-Himmelstjerna	101769-233	9825

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EXAMINER

MAKI, STEVEN D

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 10/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/713,166

Applicant(s)VON SAMSON-HIMMELSTJERNA,
MATTHIAS**Examiner**

Steven D. Maki

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>100404,021704</u> . | 6) <input type="checkbox"/> Other: ____ |

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- 1) The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- 2) Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claims 1-14, it is unclear, in light of the claims as a whole, if (a) the step of applying the double sided adhesive tape to the ribbon cable in claim 1 is required to have already been applied to the substrate and/or (b) claims 1, 2 and 8 require the double sided adhesive tape to be applied to the flat ribbon cable or the substrate prior to the moving step. In other words, the scope of claim 1 and claim 2 and claim 8 is ambiguous because (1) claim 1 and claim 8 (dependent on claim 2) appear to require the double sided adhesive tape to be applied to flat ribbon cable whereas (2) claim 2 appears to require using the apparatus to apply the double sided adhesive tape to the substrate *instead of* the flat ribbon cable.

Also, "cables" on line 6 of claim 1 should be --cable--.

- 3) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 4) **Claims 1, 9-10 and 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Europe 046 (EP 1233046) in view of admitted prior art (page 2 lines 13-28) and Japan 535 (JP 2002-101535).**

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Europe 1233046 teaches bonding parts used in automobile engineering comprising:

providing parts for an automobile wherein one of the parts may be a flat cable;

providing a double sided adhesive tape including a substrate 1 (liner) and double sided adhesive sections 2;

using a handheld labeler to apply double sided adhesive section(s) from the liner and onto one of the parts;

bringing the parts together so as to bond the parts together with the double sided adhesive section(s).

Europe 1233046 does not specifically recite applying double sided adhesive section(s) to a flat ribbon cable and bringing the flat ribbon cable and a substrate together to bond the flat ribbon cable to the substrate.

As to claim 1, it would have been obvious to one of ordinary skill in the art to **apply double sided adhesive tape section(s) to a flat ribbon cable** and then bring the flat ribbon cable and a substrate together so as to bond the flat ribbon cable to the substrate in view of (1) Europe 046's teaching to use a hand held labeler and a composite tape including double sided adhesive tape sections and a liner to bond parts for an automobile together wherein one of the parts may be a flat ribbon cable and (2) the admitted prior art suggests providing a flat ribbon cable with double sided adhesive tapes and then, in a second production step, bonding the flat ribbon cable having double sided adhesive tapes to a roof lining.

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With respect to the "mount", it would have been obvious to one of ordinary skill in the art to facilitate the step of bringing the flat ribbon cable and substrate together by **inserting the flat ribbon cable into a mount** since Japan 535 suggests inserting a flat wire harness into a setting member 1 (mount), applying adhesive, bringing the flat wire harness and a motor vehicle head lining together by moving the setting member (mount) for the benefit of correctly positioning the flat wire harness in the motor vehicle head lining.

Although Japan 535 teaches applying the adhesive by spraying, Europe 046 motivates one of ordinary skill in the art to use the double sided adhesive tape having double sided adhesive tape sections on a liner so that labeling equipment can be used to apply the double sided adhesive tape sections "very fast" to the part to be bonded. With respect to the bringing / adhesive bonding step, Japan 535 provides ample motivation (correct positioning of a "flat ribbon cable") to use setting member 1 ("mount") during adhesive bonding of the flat ribbon cable to a substrate (head lining).

As to claims 9-10, Japan 535 suggests holding the flat cable 4 in a "channel". See figure 2. The claimed height limitation in claim 10 would have been obvious in view of (1) Europe 046's teaching to bond a flat cable to a substrate using double sided adhesive section(s) and Japan 535's suggestion to hold a flat cable in a channel as shown in figure 2.

As to claims 13 and 14, Europe 046 teaches bonding flat cable to an automobile part and the admitted prior art and Japan 535 specifically suggest bonding a flat cable to an automobile roof lining.

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5) Claims 2-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Europe 046 in view of admitted prior art and Japan 535 as applied above and further in view of Schwertfeger (US 2005/056378).

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

As to claims 2-8, it would have been obvious to one of ordinary skill in the art to use the claimed apparatus in Europe 046's bonding process since (1) Europe 046 teaches using hand held labeling equipment to apply the double sided adhesive tape sections and (2) Schwertfeger' apparatus is for applying double sided adhesive tape sections. As to claim 8, Japan 535 suggests using a robot to hold means for applying adhesive.

6) Claims 2-5 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Europe 046 in view of admitted prior art and Japan 535 as applied above and further in view of German 249 (DE 2617249) and optionally Hamisch (US 6138734).

As to claims 2-5 and 8, it would have been obvious to one of ordinary skill in the art to use an apparatus comprising a handle, base plate, roll of Europe 046's double sided adhesive tape, drive roll, pressure roll and roll for receiving the liner in Europe 046's bonding process since (1) Europe 046 teaches using **hand held labeling equipment to apply the double sided adhesive tape sections from the liner of the double sided adhesive tape**, (2) German 249, directed to equipment for applying double sided adhesive tape, suggests applying double sided adhesive tape from a liner using

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an apparatus comprising a handle, **base plate; roll 1 for double sided adhesive tape; drive roll 3, pressure roll 4; roll 2 for the liner** wherein the double sided adhesive tape is peeled off the liner and applied to a substrate using a roll 4 and optionally (3) Hamisch, directed to a hand held labeler, teaches peeling a label ("section") from a liner and applying the label ("section") to a substrate using a roll 29. Hence, Europe 046 instructs one of ordinary skill in the art to use *hand held equipment* to apply the *double sided adhesive tape sections* and German 249 teaches *hand held equipment* for applying *double sided adhesive tape*. The optional Hamisch, which teaches applying *sections (labels)* using a roll of a hand held equipment constitutes evidence establishing a reasonable expectation of success for using German 249's handheld equipment for applying Europe 046's double sided adhesive tape. As to claim 3, German 249's drive roll 3 is between roll 2 for the liner and pressure roll 4. As to claim 4, it would have been obvious to provide German 249's apparatus for applying double sided adhesive tape with the claimed adjustable positioning aid since it is taken as well known / conventional per se in the art of hand held adhesive tape appliers / hand held labelers to use an adjustable means to guide / tension a backing. As to claim 5, German 249 and the optional Hamish suggests the claimed handle. As to claim 8, Japan 535 suggests using a robot to hold means for applying adhesive.

7) **Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Europe 046 in view of admitted prior art, Japan 535, German 249 and optionally Hamisch as applied above and further in view of Samuelson et al (US 5316613).**

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As to claim 6, it would have been obvious to one of ordinary skill in the art to provide the roll for taking up the liner with a brake as claimed in view of Samuelson et al's suggestion to provide a takeup hub of an adhesive dispenser with a friction brake to restrict backlash of backing.

8) Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Europe 046 in view of admitted prior art, Japan 535, German 249 and optionally Hamisch as applied above and further in view of German 602 (DE 3834602).

As to claim 7, it would have been obvious to one of ordinary skill in the art to provide the apparatus with the claimed counterplate in view of German 602's teaching to use an aid 21 to guide an apparatus for applying double sided adhesive tape.

9) Claims 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Europe 046 in view of admitted prior art and Japan 535 as applied above and further in view of Barck (US 412630).

As to claims 11-12, it would have been obvious to one of ordinary skill in the art to use adhesive tape in the channel in view of Barck's suggestion to use adhesive tape to aid temporary holding of electronic components on a board (col. 3 lines 6-20).

Remarks

10) The remaining references are of interest.

11) No claim is allowed.

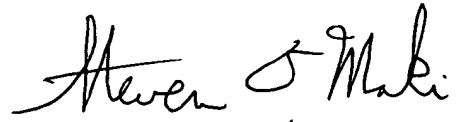
12) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven D. Maki whose telephone number is (571) 272-1221. The examiner can normally be reached on Mon. - Fri. 8:30 AM - 5:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Dunn can be reached on (571) 272-1171. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Steven D. Maki
October 2, 2005


STEVEN D. MAKI 10-2-05
PRIMARY EXAMINER
~~GROUP 1300~~
AU 1733